

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:)
) Confirmation No.: **3676**
Daniel Lee Hamilton, et al.)
)
Serial No. **10/631,973**) Examiner: **Tien C. Nguyen**
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)
Filed: **August 1, 2003**) Art Unit: **3694**
)
For: **PAYMENT PROCESSING WITH SELECTION**)
)
 OF A PROCESSING PARAMETER)
)
Docket No.: **23952-0106**)
)
Customer No.: **72386**)

**APPLICATION FOR PATENT TERM ADJUSTMENT
UNDER 37 C.F.R. § 1.705(d)**

VIA EFS-WEB

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

Applicants respectfully request reconsideration of the Patent Term Adjustment indicated with the Notice of Allowance (“NOA”) mailed on August 17, 2009.

According to the NOA, the Patent Office has calculated that the Patent Term Adjustment under 35 U.S.C. § 154(b) shall be 1203 days. Applicants submit that this determination is incorrect and that the correct Patent Term Adjustment is **1463 days**, as explained below.

A. USPTO's Calculation: The Patent Term Adjustment History available on the Patent Application Information Retrieval System (PAIR) shows, in pertinent part, an USPTO delay in the amount of 1203 days, which consists of:

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(period A) 1210 days of USPTO delay calculated from fourteen months after the application filing date on August 1, 3003, to the date the first Office Action was mailed on January 24, 2008;

(period B) 7 days of Applicant delay calculated from three months after the USPTO mailed the final Office Action on July 10, 2008, to the date the Applicants filed an Amendment and Response along with a Request for Continued Examination on October 17, 2008; and

B. Applicants' Re-Calculation: Applicants do not refute the USPTO's calculations regarding the delay periods outlined above (periods A-B). However, Applicants submit that the USPTO delay should also include delay calculated from 3 years from the application filing date of August 1, 2003, or from August 1, 2006, until the date on which a Request for Continued Examination was filed on October 17, 2008 (the "3-year pendency delay") that does not overlap with any of the USPTO's delay indicated in the NOA as period A delay. Applicants have calculated this 3-year pendency delay as 260 days of USPTO delay (i.e., 809 days between August 1, 2006 and October 17, 2008 – 542 days of overlap between August 22, 2006 and January 24, 2008 – 7 days of overlap between October 10, 2008 and October 17, 2008 = 260 days). This period of 260 days shall be added to the originally calculated period of 1203 days USPTO delay, resulting in a total Patent Term Adjustment of 1463 days.

Under 35 U.S.C. § 154(b)(1)(B), USPTO delay occurs if the issue of an original patent is delayed due to the failure of the Patent Office to issue a patent within 3 years after the actual filing date of the application in the United States (i.e., "B delay") excluding the number of days in the period beginning on the date on which a request for continued examination was filed and

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ending on the date the patent was issued (See 37 CFR § 1.703(b)(1)). In its calculation, however, the USPTO failed to consider any 3-year pendency delays prescribed by Section 154(b)(1)(B), depriving Applicants of additional patent term rightfully owed.

When re-calculating this delay, Section 154(b)(2)(A) requires accounting for and not double-counting any overlapping periods - “[t]o the extent that periods of delay attributable to [USPTO delays] overlap, the period of any adjustment granted . . . shall not exceed the actual number of days the issuance of the patent was delayed.” 35 U.S.C. § 154(b)(2)(A). The recent district court case of *Wyeth v. Dudas* interpreted this section to clarify that “overlap” as used by the statute means only those days that actually overlap on a calendar. See *Wyeth v. Dudas*, 2008 U.S. Dist. LEXIS 76063, 88 U.S.P.Q.2D (BNA) 1538 (D.C.C. 2008) (“Periods of delay that fit under [35 U.S.C. § 154(b)(1)(A)] are called ‘A delays’ The period that begins after the three-year window has closed is referred to as the ‘B delay’ If an ‘A delay’ occurs on one calendar day and a ‘B delay’ occurs on another, they do not overlap and § 154(b)(2)(A) does not limit the extension to one day.”). Accordingly, as indicated in the calculation above, Applicants have properly accounted for the overlap between the additional 3-year pendency owed and the above period A delay. Therefore, the omission of 260 days from the patent term adjustment was made in error and Applicants respectfully request it be added back to the patent term adjustment.

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CONCLUSION

Applicants hereby notify the Office of this apparent error in the Patent Term Adjustment indicated in the NOA mailed on August 17, 2009 for the above-referenced application, and respectfully request indication of a corrected Patent Term Adjustment on the resulting patent. The Commissioner is hereby authorized to charge the fee of \$200.00 required under 37 C.F.R. § 1.18(e) to Deposit Account 19-2059. The foregoing is believed to be a full and complete Application for Patent Term Adjustment under 37 C.F.R. § 1.705.

Respectfully submitted,



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Date: **September 2, 2009**

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